

## REMARKS

At the time of the Office Action, claims 1-16 were pending. In the Office Action:

- claims 1–8 and 13–16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Horowitz, U.S. Patent Application Publication 2004/0078817 in view of Shoff, U.S. Patent No. 6,240,555 in further view of Boyer, U.S. Patent No. 7,269,838;
- claims 9 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz in view of Shoff in view of Boyer in further view of Carden, U.S. Patent No. 6,996,627; and
- claims 11 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz in view of Shoff in view of Boyer in further view of Yamato, U.S. Patent Application Publication 2002/0127000.

Applicants have amended claim 1 to clarify that the record file of the selected audiovisual content is provided in response to the selecting on the presentation server--further amendments have been made on various claims for stylistic reasons; these amendments should not be construed as narrowing or a surrender of subject matter for purposes of patentability.

### **35 U.S.C. §103(a) Obviousness of Claims 1–8 and 13–16 by Horowitz in view of Shoff and Boyer**

*1. The combination of Horowitz, Shoff, and Boyer does not obviate independent claim 1 since Shoff and Boyer contain insufficient disclosures related to the inclusion of address information inserted into a record and the selection of a server-based program to record to supplement deficiencies in the teaching of Horowitz, and the asserted motivations to combine are inaccurate.*

In the Office Action, on pp. 2–4, the Examiner rejected independent claim 1 as being obvious over the combination of Horowitz, Shoff, and Boyer. The Examiner identified how various elements of claim 1 were disclosed by Horowitz, but noted that the teaching of Horowitz lacked two claimed features: the inclusion of the address of the update server in the record file

that is returned to the access terminal, and the selection of the audiovisual content to be recorded being performed on the presentation server.

The Examiner noted, on pp. 2–3, the Examiner stated:

Horowitz does not teach wherein the record file further includes the address of an update server, a step of the access terminal sending the request to the address included in the record file.

In an analogous art, Shoff teaches wherein the record file further includes the address of an update server, a step of the access terminal sending the request to the address included in the record file (data fields corresponding to a program having link to server that has additional information on the specific program which can be accessed on request, Col. 6, lines 8 - 26, Fig. 3).

Therefore, it would have been obvious to one of ordinary skill in the art to modify Horowitz' conflict management system by including a link to server with additional information as described in Shoff's supplemental content system for the advantages of reducing the burden placed on processors for finding relevant information source.

In response to the Applicants' previous response, the Examiner clarified his position by stating, on p. 2 under the "Response to Arguments" section:

In response to applicant's arguments on page 7, paragraph 1 in regards to the server address being included in the record file; Horowitz already teaches a system that receives program information, request updates and receives updates. Schoff is brought in solely for its teaching about a sent file that contains a URL to a server.

The Examiner then stated, on p. 4:

The combination of Horowitz and Shoff do not teach wherein the selection is made on a presentation server.

In an analogous art, Boyer teaches do not teach [sic] wherein the selection is made on a presentation server (internet based EPG, col. 3, lines 1–2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Horowitz and Shoff by including a system that allows remote access to the program guide as described in Boyer's internet based EPG system for the advantages of reducing the

cost of the system and providing a central location for accessing the EPG.

Applicants respectfully disagree that one of ordinary skill in the art would turn to Shoff's disclosure of including a content-oriented pointer embedded in a client-generated data record in combination with Boyer's disclosure of a selection of a linked web page within a server-based program guide to solve the deficiencies of the teachings of Horowitz to arrive at the present claim 1, with claims as amended.

Claim 1 has been amended to clarify that the record file of the selected audiovisual content that includes the address of the update server is provided in response to the selecting on the presentation server.

Claim 1 encompasses a technique used to schedule a recording of program contents that comprises selecting the content to record on the presentation server and, in response to this selection, providing the terminal with a record file.

In contrast, in Horowitz, the technique used for scheduling the recording of program contents comprises providing the terminal with EPG data relating to the content, the selection of the content to record and the generation of a request/file to record this content being performed locally in the terminal (see paragraph 0026, which states, "Process 300 then moves to block 304 where a viewer requests that a certain program (i) be recorded by the client device"; and paragraph 0027, which states, "then process 300 moves to block 312 where the request to record the content is stored in an event programs table"). Thus, the recording method of the invention and the recording method of Horowitz are based on two very different approaches.

According to claim 1, the record file for recording program content contains the address of an update server. This permits an association of a specific update server to a given program content to be recorded. In other words, different update servers can be used respectively for different contents to be recorded. The invention thus permits changing of the update server according to the specific program content to be recorded. This adaptation could not be performed when the address of the update server is pre-stored in the terminal.

Because of this, different TV servers (for example, the CNN server and the BBC server) can have their respective update servers (an update server could be integrated in the corresponding TV server or be distinct from the TV server and connected to it). In this case,

when an access terminal selects, on the presentation server, two (or more) program contents to be recorded, one from CNN and one from BBC, for example, the presentation server can then provide the access terminal with the address of the CNN update server, in the record file for the CNN content, and with the address of the BBC update server, in the record file for the BBC content.

Thus, for checking if the CNN content and the BBC content are re-scheduled, shifted or cancelled, the terminal can send two different requests respectively to the CNN update server and to the BBC update server. This would allow an update server specific to one TV channel to update directly the schedules for their contents to be recorded of the TV channel, without requiring going through an intermediate update server that must first be updated by the TV server. In this way, the updating information can be "up-to-the-minute" and more reliable, which is not possible with the Horowitz scheme.

In Horowitz, the program data is collectively retrieved by the client device, and the selection of the program to record is made at the client device. See Horowitz paragraph 0026. Whatever the origin of the address of the EPG Update Database server is in Horowitz (and Horowitz is silent on this point), the selection of the program to record on the client, as disclosed by Horowitz, means that any change in a location of the update server cannot automatically be adjusted at the time (or immediately before) of recording selection, as can be done with the present invention.

By using a server side selection of the recording, and by associating the address of the update server with the record of the program to be recorded, a much more flexible approach to updates is permitted than was contemplated in the prior art references cited by the Examiner, even collectively. Advantageously, and using the method and system claimed by the present invention, each of the content providers can direct, on a per-show basis, and at a time immediately before the user selects a program to record, change the address of the update server to accommodate, e.g., a server that is down, a server that has more available bandwidth/processing power, etc. In other words, the advantageous design of the present invention permits an update of the update server itself, which is not achievable with any of the prior art references.

The pointer mechanism that the Examiner indicates is disclosed in Shoff to show a teaching that a sent file can contain a URL to a server is not sufficient to fulfill the deficiency in the teaching of Horowitz on this point, because the teaching in Shoff relates to a pointer for media content-related data (the supplemental content/enhanced content server 52, 54 in Shoff—Figure 2). The address of the update server, as claimed in claim 1, is process- or procedure-related data that is not associated with the media-content itself. Thus, one of ordinary skill in the art would not turn to a disclosure of a media content-related data pointer when trying to address process issues such as where to go for update data.

Furthermore, the Examiner's stated motivation to combine Shoff with Horowitz is incorrect as well. The Examiner indicates that one would be motivated to modify Horowitz with the teaching of Shoff "for the advantages of reducing the burden placed on processors for finding [the] relevant information source." The address of the update server is presumed to be known in Horowitz by the server... however, with the address incorporated into the record received from the server, the burden on the client processor would actually be *increased*, since the processor would have to segregate this address from the data received and then store it in some location prior to use.

The Examiner included the Boyer reference as teaching that a selection is made on a presentation server (citing the Internet-based EPG at 3:1–2 in Boyer). Boyer states, in the cited section:

Because the Internet television program guide system with embedded real-time data may be provided using a web site having a number of linked web pages...

Although clearly a web-based program guide system having linked web pages would logically permit some form of selection (such as selecting one of the links to the web page), Boyer is completely silent on using such a mechanism in the context of recording, and thus its disclosure is insufficient to fulfill the deficiency in the teaching of Horowitz related to a server-based selection related to the recording of a program.

Furthermore, the Examiner indicated that a part of the motivation to combine the teaching of Boyer with that of the combined Horowitz and Schoff references would be to reduce costs of the system. However, a client-server-based architecture does not necessarily reduce costs, and can cost more in many cases since the server architecture (at least the server

architecture disclosed by Boyer) must support software that provides a user interface into the server. The additional server software of Boyer to support the user interface functions would serve to increase the costs if combined with Horowitz, not reduce costs.

As noted by MPEP §2141.02(V), the invention as a whole must be considered in undertaking the obviousness inquiry and not look only to the subject matter that is literally recited in the claim in question. The consideration of the invention as a whole does not permit merely locating individual elements of the claim in various pieces of prior art—doing so reflects the use of hindsight that is expressly forbidden in the obviousness determination.

Claims 2–8 and 13–16 are similarly not obviated by the combination of Horowitz, Shoff, and Boyer by virtue of their dependence from independent claim 1.

2. *In addition to the arguments provided above, claim 6 is not obviated by the combination of Horowitz, Shoff, and Boyer because there is no teaching or suggestion of sending a request to update increasingly often as the date and time for recording approaches.*

In the Office Action, on pp. 5–6, the Examiner rejected dependent claim 6 as being obvious over the combination of Horowitz, Shoff, and Boyer, stating:

As per claim 6, the combination... [teaches] a method according to claim 1 of recording audiovisual contents broadcast according to a schedule, wherein, during the selection step a single audio visual content is selected, and wherein the terminal sends the request to update the record file increasingly often as the date and time for recording the selected audiovisual content approaches (regular updates [0031], lines 7–15).

Applicants can find no teaching in Horowitz related to sending a request to update increasingly often. All that is provided in this disclosure are examples that show a spaced pair of requests that are made, but nothing showing increasingly often requests. In the event that the Examiner maintains this rejection, Applicants respectfully request that the Examiner specifically indicate how Horowitz discloses *increasingly often* requests.

For these reasons, Applicants respectfully request that this 35 U.S.C. §103 rejection be withdrawn from the application.

**35 U.S.C. §103(a) Obviousness of Claims 9–12 over Horowitz, Shoff, and Boyer in view of Some Combination of Carden and Yamato**

*3. Applicants rely upon the above arguments with respect to the remaining dependent claims, and assert that none of the additional references supplants the deficiencies identified above with respect to the combination of Horowitz, Shoff, and Boyer.*

In the Office Action, on pp. 7–10, the Examiner combined Horowitz, Shoff, and Boyer with Carden and Yamato in establishing an obviating combination of references for various dependent claims in the present application. Without addressing the specifics of the additional references on the merits, Applicant relies upon the above arguments and asserts that the disclosures of each of Carden and Yamato, alone or in combination, does not serve to solve the deficiencies of the combined Horowitz, Shoff, and Boyer references. The Examiner has cited Carden and Yamato for purposes related to the specifics of the dependent claims.

For these reasons, the Applicant asserts that the claim language clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw the §103 rejection from the present application.

**CONCLUSION**

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/mark bergner/

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